

**REMARKS**

The applicants respectfully request reconsideration in view of the amendment and the following remarks. The applicants have cancelled the non-elected claims and reserve the right to file a divisional application on these claims. In order to expedite prosecution the applicants have incorporated the feature of objected claim 45 into independent claim 35. The applicants again reserve the right to file a continuation application on claim 35. The applicants have rewritten claims 39 and 40 into independent form. Claim 39 is now new claim 59. The applicants have corrected the dependencies of claims 46, 47, 54 and 55 as suggested by the Examiner in order to overcome the 35 USC §112, second paragraph rejection.

The applicants appreciate that the Examiner has acknowledged that claims 26, 27 and 38 are allowable over the prior art. These claims are in independent form and should be allowable.

Claims 26, 35-38, 40-44 and 46-59 are in this application. The applicants have added two independent claims (claims 40 and 59) and cancelled one independent claim (claim 1). A fee of \$86.00 is enclosed for the extra independent claim over three added. Claims 26, 35, 37, 38, 40, 51 and 59 are the independent claims in this application.

Claims 46, 47, 54 and 55 were rejected under 35 USC §112, second paragraph rejection. Claims 35-36, 41-42, 44 and 48-50(?) were rejected under 35 U.S.C. § 102(b) as being anticipated by Gary *et al.* "Preparation and Properties of Some alpha Azo-amino-acid Derivatives, Their Possible Use in Peptide Synthesis" ("Gary"). Claims 35-36, 41, 42, 44 and 48-50 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ryono *et al.* U.S. Patent No. 4,885,292 ("Ryono"). Claims 35-36, 41, 42, 44 and 48-50 were rejected under 35 U.S.C. §

102(b) as being anticipated by Patel U.S. Patent No. 5,217,958 (“Patel”). Claims 35-36, 41, 42, 44 and 48-50 were rejected under 35 U.S.C. § 102(b) as being anticipated by Norbeck *et al.* U.S. Patent No. 5,461,067 (“Norbeck”). Claims 35-36, 41, 42, 44 and 48-50 were rejected under 35 U.S.C. § 102(b) as being anticipated by Al-Razzak *et al.* U.S. Patent No. 5,484,801 (“Al-Razzak”). Claims 51-52 and 57-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gary. Claims 51-52 and 57-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryono. Claims 51-52 and 57-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Patel. Claims 51-52 and 57-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Norbeck. Claims 51-52 and 57-58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Al-Razzak. The applicants respectfully traverse these rejections.

The applicants appreciate that the Examiner indicated that claims 37-40, 43, 45 and 53-54 contain allowable subject matter. The applicants have incorporated the features of claim 45 into independent claim 35. Applicants also believe that claim 26, since it is an independent claim, should also be allowable. This claim has not been rejected. Claims 37, 38 and 40 are in independent form. Claim 39 is now new claim 59.

#### **Section 112 Rejection**

Claims 46, 47, 54 and 55 were rejected under 35 USC §112, second paragraph rejection. The applicants have corrected the dependencies of claims 46, 47, 54 and 55 as suggested by the Examiner in order to overcome the 35 USC §112, second paragraph rejection. The applicants appreciate the Examiner pointing out these typographical errors with respect to the dependencies.

#### **Section 102(b) Rejections**

Claims 35-36, 41-42, 44 and 48-50 were rejected under 35 U.S.C. § 102(b) as being anticipated by Gary, Ryono, Patel, Norbeck and Alrazzak. Claim 35 is the only independent claim anticipated by these references. The applicants have incorporated the features of allowed claim 45 into claim 35. Therefore, these rejections should be withdrawn.

### **Section 103(a) Rejections**

Claims 51-52 and 57-58 were rejected under 35 U.S.C. § 102(b) as being obvious over Gary, Ryono, Patel, Norbeck and Alrazzak. In all the rejections, the Examiner stated

The instant claims are directed to the **thio analog** of [Gary, Ryono, Patel, Norbeck and Alrazzak] compounds. **It would be obvious to the artisan in the art with teachings to the compounds of [Gary, Ryono, Patel, Norbeck and Alrazzak] to prepare its thio analog compounds rendering the instant claims** obvious (see page 4, 4<sup>th</sup> full paragraph, page 5, 1<sup>st</sup> full paragraph and the 4<sup>th</sup> full paragraph, 7<sup>th</sup> full paragraph and page 6, 2<sup>nd</sup> full paragraph of the Final Office Action). (Emphasis added)).

In none of these references is there a teaching to substitute “oxygen” for the “thio” group as is required by the applicants’ claimed invention. The Examiner has not asserted why it would have been obvious other than stating that it is an analog. However, the applicants disagree. Substituting sulfur for oxygen in the applicants claimed formula is not obvious.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by the prior art (In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). **In this case there is no suggestion or**

**teaching in the prior art references to modify the references by substituting the oxygen for**

**the sulfur**. The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction. For the above reasons, this rejection should be withdrawn.

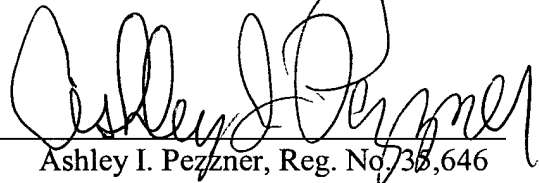
A one month extension fee has been paid. If there are any additional fees due in connection with this filing, the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

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